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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,641	04/02/2004	Kia Silverbrook	HYG006US	9668
24011	7590	12/19/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			ST CYR, DANIEL	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,641

Applicant(s)

SILVERBROOK ET AL.

Examiner

Daniel St.Cyr

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 0204.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 12, 13 and 19-44 is/are rejected.
- 7) ☒ Claim(s) 3-11 and 14-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged that claims 1-44 are presented for examination.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia on 04/07/03 and 04/15/03. It is noted, however, that applicant has not filed certified copies of the Australian applications as required by 35 U.S.C. 119(b).

Claim Objections

3. Claim 36 is objected to because of the following informalities: line 4, "it" should be changed to --the scanning patch--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 12, 13, 19-22, 26, 29, 30, 32-35, and 37-44 rejected under 35 U.S.C. 102(b) as being anticipated by Marcum, US Patent No. 6,314,337.

Marcum discloses an automated consolidation station comprising: a sensing device 24 for sensing at least one coded data portion (chassis/tote ID); generating, using the sensed coded data portion, indicating data indicative of the identity of the object; and, transferring the indicating data to at least one of: a packing system which is responsive to the indication to pack the object; computer system which is responsive to the indication to cause a packing system to pack the object, wherein in the packing system: receiving the indicating data; generating, from

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the received indicating data, object identity data indicative of the identity of the object; and, packing the object using the object identity data. Marcum discloses all the elements and the functional/method steps of these claims (see figs. 1-3, col. 3, line 35-col. 4, line 51).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 23-25, 27, 28, 31, and 36, are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcum. The teaching of Marcum have been discussed above.

Marcum does not disclose the EPC. However, Official Notice is taken that the EPC code format is old and well known. It would have been obvious to a person of ordinary skill in the art to use the EPC format in Marcum in order to make the Marcum invention easily implemented in Europe, to make it more versatile.

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Marcum does not disclose the redundancy as claimed. Official Notice is also taken that redundancy in coded information is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide redundant information in the code of Marcum, thereby helping to ensure a readable code in the case where a portion of the code may be damaged. With respect to the specific type of redundancy, such limitation falls within the engineering choice for meeting specific requirement, failing to provide any unexpected results, which therefore, an obvious extension as taught by Marcum.

Marcum does not disclose the invisible code or IR ink. Official notice is taken that bar codes printed, in IR ink are old and well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to print the code of Kawai in IR ink. This would effectively obscure the code from the naked eye and thus would not visibly interfere with the surface of a product.

Marcum does not disclose that the code takes up at least 25% of the product surface. Official notice is taken that codes printed on more than 25% of a surface of a product is known. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to print the code on more than 25% of the product surface in order to maximize the amount of information held within the code.

Marcum does not disclose laser scanners. However, laser scanners are old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Marcum with laser scanners for reading code information. This would provide better signal quality to more optimal reading and thus would enhance the overall system performance.

Allowable Subject Matter

9. Claims 3-11 and 14-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or fairly suggest to one of ordinary skill in the art at the time the invention, in conjunction with all the other claimed limitations, the position, the orientation, of the sense code data portion, the orientation of the sensed device relative to the interface surface, indicating data indicative of the region identity, etc., as set forth in the claims.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

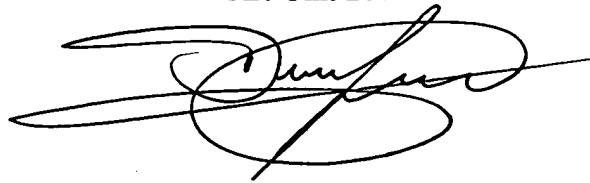
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Daniel St.Cyr
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Daniel St. Cyr', with a large, stylized flourish at the end.

DS
December 9, 2005